

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today
(1) was **not** written for publication in a law journal and
(2) is **not** binding precedent of the Board.

Paper No. 30

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte YVES HERBELLEAU

Appeal No. 1999-0983
Application No. 08/782,891

ON BRIEF

Before CALVERT, NASE, and JENNIFER D. BAHR, Administrative
Patent Judges.

CALVERT, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal from the final rejection of claims 14
and 17. Claims 1 and 18, the only other claims remaining in
the application, have been allowed.

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The claims on appeal are drawn to a tire, and are reproduced in the appendix to appellant's brief.¹

Claims 14 and 17 stand finally rejected on the following grounds:

- (1) For failure to comply with the written description requirement of 35 U.S.C. § 112, first paragraph;
- (2) For failure to comply with 35 U.S.C. § 112, second paragraph.

Rejection (1)-Written Description

The initial portion of claim 14 reads (emphasis added):

A tire including a bead on each side of the equatorial plane of the tire, a circumferentially extending carcass anchoring means embedded in each bead, said carcass anchoring means having a radially inner and axially inner edge, . . .

The examiner asserts that there was no written description, as required by 35 U.S.C. § 112, first paragraph, of the claimed "carcass anchoring means" in the application as filed.

The term "carcass anchoring means" does not appear in the

¹ In reviewing the claims, we note that "the inner side wall" in line 6 of claim 14 does not appear to have a clear antecedent basis in the claim.

specification or claims of the originally-filed application.²

However, at page 6, line 26, to page 7, line 13, of the original specification appellant discloses:

The tire bead shown in Fig. 1 comprises a bead wire 3 formed in this case by the winding of a profiled member of curved cross section. It also comprises a carcass 1 of the monofil type anchored to the bead wire by the fact that the single cord constituting the carcass forms forward and return paths with respect to each bead wire around which it is very intimately pressed. The carcass and the anchoring thereof to a bead wire are constructed in the manner explained in US Patent 4,801,344. This arrangement is, to be sure, not limitative, and other arrangements can be adopted within the bead. All the components which the bead contains have not been indicated in detail since, in general, the present invention does not directly concern their selection and location, but essentially proposes a new shape for the inner edge of the bead.

Thus, the original application discloses that bead wire 3 anchors the carcass. Nevertheless, the examiner contends that there is no written description of "carcass anchoring means," i.e., it is new matter, because (answer, page 6):

one of ordinary skill in the art would not have known from the original disclosure that the carcass

² Application No. 08/284,809, filed August 2, 1994, of which the present case is a file wrapper continuation under 37 CFR § 1.62 (1995).

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anchoring
function was the only feature of the bead wire
pertinent to the claimed invention and therefore
would not have understood appellant to have
implicitly disclosed any possible carcass anchoring
means by explicitly reciting only the bead wire.

We agree with the appellant and, apparently, the examiner
that "carcass anchoring means" is a means-plus-function
expression within the purview of 35 U.S.C. § 112, sixth
paragraph. As such, the sixth paragraph provides that it
shall be construed to cover the corresponding structure
described in the specification (i.e., the bead wire) and
equivalents thereof; the examiner's implication, supra, that
it covers "any possible carcass anchoring means" is a broader
interpretation than the statute provides. See In re Donaldson
Co., Inc., 16 F.3d 1189, 1195, 29 USPQ2d 1845, 1850 (Fed. Cir.
1994).

The examiner seems to be of the opinion that, for a
disclosed structure to be the structure which corresponds to a
means-plus-function, the claimed function must be the only
feature of the structure which is pertinent to the claimed
invention. We are aware of no authority for this proposition

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and do not agree with it, there being no such restriction in the statute or case law.

Since, as discussed above, under the sixth paragraph of § 112, "carcass anchoring means" is construed to cover the bead wire and equivalents thereof, the question remains as to whether, assuming arguendo that § 112, first paragraph, requires that the originally-filed application have included a written description of such "equivalents thereof," said application in fact did so. It is of course not necessary that specific equivalents be described in the specification, "for such a requirement would render [§ 112, sixth paragraph] meaningless." Toro Co. v. White Consol. Ind., Inc., 199 F.3d 1295, 1300, 53 USPQ2d 1065, 1068 (Fed. Cir. 1999). Rather, we apply the fundamental test for compliance with the written description requirement, namely, would the application as filed, considered as a whole, have conveyed to one of ordinary skill in the art, either explicitly or inherently, that applicant invented the subject matter claimed. Reiffin v. Microsoft Corp., 214 F.3d 1342, 1346, 54 USPQ2d 1915, 1917 (Fed. Cir. 2000).

In the present case, we consider that this test is met

with regard to the "equivalents" of the bead wire, so that appellant's recitation of "carcass anchoring means" for the first time in a non-original claim does not constitute new matter.³ In the first place, it is not clear that "carcass anchoring means" does in fact include structure other than a bead wire, since the examiner has not identified anything known in the art which would be the equivalent of a bead wire under § 112, sixth paragraph.⁴ Secondly, we consider that the above-quoted disclosure from page 6, line 26, to page 7, line 13, of the specification would have conveyed to one of ordinary skill that appellant was in possession, not only of a bead wire as an element of the invention, but also of equivalents of the bead wire. Thus, as stated on page 7, lines 7 to 9, the arrangement of the carcass and anchoring to a bead wire is "not limitative, and other arrangements can be adopted within the bead." Also, in lines 9 to 13 appellant

³ "Carcass anchoring means" was first recited in a claim when claim 4 was amended and claim 14 was added by amendment filed August 16, 1995 (Paper No. 8).

⁴ An equivalent structure under § 112, sixth paragraph, must be a structure that was available at the time of the issuance of the claim. Al-Site Corp. v. VSI Int'l., Inc., 174 F.3d 1308, 1320, 50 USPQ2d 1161, 1168 (Fed. Cir. 1999).

discloses that "the present invention does not directly concern . . . selection and location [of all the components which the bead contains], but essentially proposes a new shape for the inner edge of the bead." In our view, this disclosure would have conveyed to one of ordinary skill that the tire which appellant invented was not limited to containing a bead wire, but rather contained a "carcass anchoring means," to the extent that that term includes equivalents of a bead wire.

Accordingly, rejection (1) will not be sustained.

Rejection (2)-Indefiniteness

In this rejection, the examiner finds lack of compliance with the second paragraph of § 112 on two grounds.

First, the examiner finds claim 17 to be indefinite because "surface" (line 2) has no antecedent basis. Appellant does not disagree, but rather agrees to amend the claim appropriately (reply brief, page 1). This ground of the rejection will therefore be summarily sustained.

Second, the examiner asserts that "what is included by appellant's use of the term 'carcass anchoring means' other than the bead wire cannot be determined in light of the specification" (answer, page 5). We disagree. As discussed

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under rejection (1), the specification discloses that the bead wire performs the function of anchoring the carcass.

Therefore, pursuant to § 112, sixth paragraph, "carcass anchoring means" is construed to cover the bead wire and equivalents thereof. Appellant is not required to describe in the specification what these equivalents (if any) are. Toro Co., supra. The term "carcass anchoring means" accordingly does not render the scope of the claims indefinite, and we will not sustain this ground of rejection (2).

Conclusion

The examiner's decision to reject claims 14 and 17 under § 112, first paragraph, is reversed, and to reject said claims under § 112, second paragraph, is reversed as to claim 14 and sustained as to claim 17.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED-IN-PART

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| IAN A. CALVERT |) | |
| Administrative Patent Judge |) | |
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| |) | BOARD OF PATENT |
| JEFFREY V. NASE |) | |
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